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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,974	10/11/2000	Seishi Murakami	8279.284USWO	6973

7590 12/15/2004
Merchant & Gould P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903

EXAMINER
AKHAVAN, RAMIN

ART UNIT	PAPER NUMBER
1636	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

12/15/04 R

Office Action Summary

Application No.

09/622,974

Applicant(s)

MURAKAMI ET AL.

Examiner

Ramin (Ray) Akhavan

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-8 are pending and under consideration in this action. Receipt of preliminary amendments, filed 08/24/2000 (claims 3 and 4) and 11/27/2000 (p. 4, ll. 8-9), is acknowledged, however the amendments have not been entered. The claims have been examined and restricted as though the amendments of the claims are entered, but in response to this restriction requirement, Applicant should submit the amendments so as to remove multiple dependency as previously intended. Applicant can also resubmit the amendment to the specification, changing a reference to a non-patent publication, but it is noted that the substitute reference is of an entirely distinct authorship (i.e. Tan, BE is not one of the authors for the substitute reference) thus would likely be New Matter.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. The groups are as follows:

Group I, claims 1-3 and 6-8 drawn to nucleic acid molecules, vector molecules containing and method of expressing said nucleic acid molecules.

Group II, claims 4-5, drawn to a recombinant protein..

In accordance with 37 CFR 1.499, in response to this action applicant is required to elect a single invention to which the claims must be restricted.

The inventions listed in Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because under PCR Rule 13.2 which indicates that unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features (i.e. technical features that define a contribution which each of the inventions considered as a whole makes over the prior art).

The special technical feature of Group I is directed to nucleic acid molecules, which biologically have a distinct functional characteristic as compared to proteins. For example, nucleic acid molecules function to encode a protein, or are able to hybridize with complementary sequences of RNA or DNA. The special technical for Group II is directed to a protein with its attendant functionality in a cellular mechanism. Nucleic acids and proteins are biologically distinct molecules with disparate functionalities. Furthermore, a nucleic acid molecule could be used to express proteins that do not function in the proposed activity. Irrespective of the proposed functionality however, inventions directed to nucleic acid molecules versus protein molecules do not share a special technical feature, thus are restrictable.

Applicant is advised that a reply to this restriction requirement must include an election for the invention (i.e. Group I or II) to be examined, for the reply to be complete, notwithstanding that the requirement be traversed (37 CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if none or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

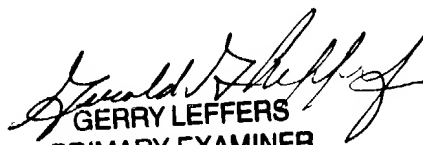
The claims encompass two separate inventions, thus are subject to a restriction requirement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ray Akhavan whose telephone number is 571-272-0766. The examiner can normally be reached between 8:30-5:00, Monday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, PhD, can be reached on 571-272-0781. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully submitted,

Ray Akhavan/AU 1636


GERRY LEFFERS
PRIMARY EXAMINER